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No. 325

IN THE

Supreme Court of the United States

OCTOBER TERM, 1949

FORREST H. SMITH, et al.,

Petitioners,

vs.

GENERAL FOUNDRY MACHINE COMPANY, INCORPORATED, et al.,

Respondents.

PETITION FOR WRIT OF CERTIORARI AND BRIEF IN SUPPORT THEREOF

CLARENCE M. FISHER,
W. BROWN MORTON,
Counsel for Petitioners.

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PETITION FOR WRIT OF CERTIORARI

TO THE HONORABLE, THE CHIEF JUSTICE AND ASSOCIATE JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

Your petitioners, Forrest H. Smith, et al., pray that a writ of certiorari issue to the United States Court of Appeals for the Fourth Circuit to review the judgment of that court in this cause filed May 6, 1949 (R. 143). A petition for rehearing was denied on June 13, 1949 (R. 149).

A certified transcript of the record in this case, including the proceedings in the Court of Appeals, is furnished herewith in compliance with Rule 38 of the Rules of this Court.

Summary Statement of the Matter Involved

This action arose as an action by petitioners charging respondents with infringement of claims 1, 2 and 3 of petitioners' patent No. 1,811,980, dated June 30, 1931, and claim 3 of petitioners' patent No. 2,051,348, dated August 18, 1936, relating to drying houses for curing tobacco.

Respondents, on the 2nd day of July, 1948 filed a motion for summary judgment (R. 26) on the grounds that the claims relied upon by respondents had not been infringed by respondents. The question of the validity of the claims was not raised by the motion.

The construction of respondents' drying house alleged to constitute the infringement was sufficiently disclosed by the affidavits and accompanying photographs and prints filed in connection with the motion.

Petitioners contended before the lower Court and also before the Court of Appeals of the Fourth Circuit that on a motion for summary judgment involving merely the question of infringement and not the question of validity, the sole question presented was whether or not the language of the claims construed in accordance with the plain import of their terms, so limited the claims as to exclude respondents' structure. In other words, that for the purpose of the motion the claims must be considered as valid and of a scope commensurate with their terms. The lower Court granted the motion without opinion.

The Court of Appeals for the Fourth Circuit, although finding that the combination of elements recited in the claims relied upon was present in respondents' drying house, read into the claims certain additional limitations from the specification, and when so construed found that said claims were not infringed by the respondents' structure.

The drying house disclosed in the patents in suit consists of a tobacco drying barn of ordinary construction provided with so-called flues, also of ordinary construction, said flues consisting of large sheet metal pipes placed about the floor of the barn, usually around the walls, and also across the middle of the barn and connected to a common smoke stack on the outside of the barn. Prior to the invention of the patents in suit it was the common practice to connect the flues to a furnace which was in almost every instance designed for burning wood (R. 42). By the petitioners' invention it was proposed to do away with the wood-burning furnace which was usually installed in the wall of the barn to be fired from the outside, and in lieu thereof to heat the flues by oil burners placed in the barn beneath openings cut in the bottom of the flues.

The patentee contended that by his improvement the individual burners could be spaced about the barn floor in such manner that the flues would be uniformly heated, as distinguished from the prior installations wherein the flues were heated to a higher temperature at one side of the barn adjacent the furnace than prevailed in the flues at their ends connected to the stack. The drawings of the patents in suit disclosed fifteen burners distributed at spaced intervals beneath the flues.

The patents in suit also describe and claim the novel method of connecting the individual flues to the burners, namely, by placing the individual burners under holes in the bottoms of the flues whereby the hot gases generated by the burners pass directly into the flues, and the flues, which are interposed between the burners and the overhanging tobacco, protect the tobacco from the direct radiation of heat from the burners.

Claim one of Patent No. 1,811,980 is typical of the claims in suit.

> "1. In a drying house, the combination with a substantially horizontal flue, extending adjacent to and inside of the walls of said house; of a plurality of spaced openings in the bottom of said flue; a fluid fuel burner positioned under each of said openings; and means for supplying fluid fuel to said burners."

The respondents' structure charged to infringe comprises the usual tobacco barn with the flues arranged around the walls of the barn and also across the middle, and with two burners within the barn each of which is placed beneath a hole on the under side of a cast iron elbow forming part of the flue system. The two burners are so placed with respect to the outside flue connections that each burner heats one half of the flues.

The Court of Appeals, in holding that the claims were not infringed, held that the word "plurality", although including two, should be read in connection with the drawings which show fifteen burners because, according to the Circuit Court of Appeals, a greater number than two burners were required to obtain the "prime purpose" of petitioners' invention, namely, the uniform distribution of heat.

> "We have seen that the prime purpose of the patent was to do away with a central heating system, with its loss of heat and lack of uniformity of temperature in various parts of the drying house, and to substitute a plurality of individual heating units spaced apart and variously located under the flue inside the warehouse so that the heat would be evenly distributed and easily controlled throughout the building" (Opinion, p. 7, R. 143).

Although the Court of Appeals of the Fourth Circuit in its opinion stated that "there is no genuine issue as to any material fact", its decision that the claim must be construed by reading into it limitations from the speci-

fication is itself a decision on an issue of material fact with respect to which petitioners have been denied the opportunity to present evidence. In the case at bar the Court has gone beyond the terms of the claim in an attempt to construe the claim as commensurate with what the Court, on the meager record before it, believes to be the patentee's invention.

The Court's conclusion as to what constitutes the patentee's invention is a decision on "an issue of material fact"—usually the most important fact issue presented in a patent case.

This Court has frequently ruled, that even upon a trial on the merits, the specification of the patent is not to be resorted to in construing the claims either to enlarge or restrict their scope.

> *Graver Tank & Mfg. Co., Inc.*, v. *Linde Air Products Co.*, 336 U. S. 271, 276.
>
> "The Court of Appeals considered that because there was nothing in the record to show that the applicants for the patent intended by these claims to assert a monopoly broader than nine metallic silicates named in the specifications, the court should have construed the claims as thus narrowed and limited by the specifications.
>
> The statute makes provision for specification separately from the claims and requires that the latter 'shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery.' R. S. § 4888, as amended, 35 U. S. C. § 33. It would accomplish little to require that claims be separately written if they are not to be separately read. While vain repetition is no more to be encouraged in patents than in other documents, and claims like other statements may incorporate other matter by reference, their text must be sufficient to

'particularly point out and distinctly claim' an identifiable invention or discovery.

We have frequently held that it is the claim which measures the grant to the patentee. See, for example, Milcor Steel Co. v. Fuller Co., 316 U. S. 143, 145 [53 USPQ 268, 269-270]; General Electric Co. v. Wabash Co., 304 U. S. 364, 369 [37 USPQ 466, 468-469]; Altoona Theatres v. Tri-Ergon Corp., 294 U. S. 477, 487 [24 USPQ 308, 313]. While the cases more often have dealt with efforts to resort to specifications to expand claims, it is clear that the latter fail equally to perform their function as a measure of the grant when they overclaim the invention. When they do so to the point of invalidity and are free from ambiguity which might justify resort to the specifications, we agree with the District Court that they are not to be saved because the latter are less inclusive. Cf. General Electric Co. v. Wabash Co., 304 U. S. 364, 373-374 [37 USPQ 486, 470]; see McClain v. Ortmayer, 141 U. S. 419, 424-425; Cimiotti Unhairing Co. v. American Fur Refining Co., 198 U. S. 399, 410."

In granting the motion for summary judgment for noninfringement on an interpretation of the claims not in accord with the meaning of their plain terms, the Court of Appeals for the Fourth Circuit followed a practice condemned by this Court in *Sartor* v. *Arkansas Natural Gas Corporation*, 321 U. S. 620, and directly in conflict with the ruling of the Court of Appeals for the Third Circuit in *Frederick Hart & Co., Inc.* v. *Recordgraph Corporation*, 169 F. 2d 580, 581 (C. C. A. 3):

"We are of the opinion that the District Court erred. It is well-settled that on motions to dismiss and for summary judgment, affidavits filed in their support may be considered for the purpose of *ascertaining whether an issue of fact is presented, but they cannot be used as a basis for deciding the fact issue.*

An affidavit cannot be treated, for purposes of the motion to dismiss, as proof contradictory to well-pleaded facts in the complaint. Farrall v. District of Columbia, Amateur Athletic Union, 1946, 80 U. S. App. D. C. 396, 153 F. 2d 647; United States v. Association of American Railroads, D. C. Neb. 1945, 4 F. R. D. 510; 2 Moore's Federal Practice (2nd ed. 1948) pages 2254, 2255.

It is also well-settled that on a motion to dismiss the complaint must be viewed in the light most favorable to the plaintiff and that the complaint should not be dismissed unless it appears to a certainty that the plaintiff would not be entitled to relief under any state of facts which could be proved in support of his claim; further, no matter how likely it may seem that the pleader will be unable to prove his case, he is entitled, upon averring a claim, to an opportunity to try to prove it."

When the Court of Appeals of the Fourth Circuit concluded that in order for the claims in suit to be commensurate with the patentee's invention it was necessary to read into them limitations from the specifications, the Court of Appeals should have terminated its consideration and denied the motion.

Hart v. *Recordgraph, supra,* (p. 583):

"The foregoing clearly establishes the *existence of a fact issue* with respect to what was actually said by Murray to Weber. It was at that point that the District Court's consideration should have terminated and Recordgraph's motion denied. Instead, the District Court proceeded to *decide* the fact issue and thereby committed error under the applicable principles of law stated earlier in this opinion. It is immaterial that it *decided* the fact issue in Recordgraph's favor—the point is that it went beyond its

province to resolve any fact issue on a motion to dismiss or for summary judgment. Cf. Sarnoff v. Ciaglia,, 3 Cir., 1947, 165 F. 2d, 167."

Even if it be assumed that the specification of the patent may properly be resorted to for limitations not expressed in the claims, the Court of Appeals erred in limiting the claims to include the elements which it believed to be necessary for carrying out the "prime purpose" of the invention, as the claims themselves, without such limitation, define a novel sub-combination, namely, the construction and arrangement of the individual burners with respect to the flues, which is useful whether or not sufficient burners are employed to attain the prime purpose of the invention. It is the established rule of this Court that such combinations are patentable, and as the question of validity was not before the Court the claims should have been construed as defining a novel and patentable sub-combination which is incorporated in the respondents' structure.

Jurisdiction

The jurisdiction of this Court is invoked under Sec. 240(a) of the Judicial Code as amended by the act of February 13, 1925, c. 229 (28 U. S. Code, Sec. 347).

The judgment of the Court of Appeals for the Fourth Circuit which petitioners seek to have reviewed was entered on May 6, 1949 (R. 143) and petition for rehearing denied on June 13, 1949 (R. 149).

Question Presented

The question presented is whether a Court, on a motion for summary judgment for non-infringement, may read into the claims additional limitations from the specifications in an attempt to construe the claims as commensurate with the invention.

Reasons for Granting the Writ

The question presented by this petition is a procedural question with respect to which there is direct conflict between the decision here and the rule of the Circuit Court of Appeals for the Third Circuit in *Hart* v. *Recordgraph, supra*. The question has not been decided by this Court, but should be, as motions for summary judgment in patent cases are frequently presented in an effort by a litigant to save the cost of litigation which in patent cases is usually burdensome. While it is highly desirable that unnecessary litigation expense be avoided, the procedure should not be carried so far as to deny litigants their day in Court.

WHEREFORE YOUR PETITIONERS respectfully pray that a writ of certiorari be issued to the United States Court of Appeals for the Fourth Circuit to the end that this cause may be reviewed and determined by this Court; that the judgment of the Court of Appeals for the Fourth Circuit be reversed; and that petitioners be granted such other and further relief as may be proper.

CLARENCE M. FISHER,
W. BROWN MORTON,
Counsel for Petitioners.

New York, September 8, 1949.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

Opinion of Courts Below

The decision of the District Court appears at page 51 of the Record and is not reported. The opinion of the Court of Appeals for the Fourth Circuit appears at page 136 of the Record and is reported in 174 F. 2d 147.

Jurisdiction

The jurisdictional statement appears in the accompanying petition.

Statement of the Case

The essential facts of the case are stated in the accompanying petition and need not be related here.

Specification of Errors

1. The Court of Appeals for the Fourth Circuit erred in reading into claims 1, 2 and 3 of Patent No. 1,811,980 limitations not expressed therein.

2. The Court of Appeals for the Fourth Circuit erred in not holding that as the language of claims 1, 2 and 3 of Patent No. 1,811,980 did not clearly exclude the accused structure, the question of infringement could not be decided on motion for summary judgment.

3. The Court of Appeals for the Fourth Circuit erred in not holding that as claims 1, 2 and 3 of Patent No. 1,811,980 define a useful sub-combination, they are infringed

by respondents' structure, regardless of the number of burners employed.

4. The Court of Appeals for the Fourth Circuit erred in not holding that claim 3 of Patent No. 2,051,348 covers an improvement on the structure of the individual burners as used in the combination covered by Patent No. 1,811,980 and that that modification is incorporated in respondents' burners.

ARGUMENT

I

The practice of reading into the claims from the specification or elsewhere limitations not therein expressed is so clearly contrary to the ruling of this Court in *Graver, et al.* v. *Linde, supra,* that further argument is superfluous. The claims are not ambiguous. The patentee obviously chose the word "plurality" to designate the number of burners in order that the claims should not be limited in that respect.

II

The question of infringement is a question of law for the Court only when the claims are read as they should be, in accordance with the principles laid down in the case of *Graver, et al.* v. *Linde, supra.*

The purpose of claims is to define the metes and bounds of the grant. If the language of the claims clearly excludes the respondents' structure the issue of infringement may be disposed of by motion for summary judgment. If the language of the claims does not explicitly exclude respondents' structure, then the motion should be denied because any construction of a claim at variance

with its plain language involves the determination of fact issues. In the case at bar the Court has attempted to construe the claims not in accordance with their terms, but in accordance with what the Court believes to be the scope of the patentee's invention.

The scope of a patentee's invention is the fundamental question presented in any infringement case, to determine which it is necessary to determine the state of the art at the time of the patentee's invention and the nature and extent of the departure from existing practice, by a comparison of the patented structure with the existing apparatus. To make this comparison on the basis of excerpts from file wrappers of abandoned applications* (Opinion, R. 142) and from statements in the specification that central heating furnaces are old (Opinion, R. 141)** is directly contrary to the established principle that fact issues are to be determined on the basis of evidence submitted to the jury or to the trial Judge, in cases where a jury is waived or is not required.

III

The claims define a patentable sub-combination.

Special Equipment Company v. *Coe, Com'r. Pats.*, 324 U. S. 370:

> "The statutes permit, and it is the settled practice of the Patent Office, many times sustained by this Court, to allow claims to a combination and also its sub-combinations. Railroad Co. v. Dubois, 12 Wall. 47, 60; Deering v. Winona Harvester Works, supra;

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* The matter quoted from the opinion relates to a different heating system wherein no flues are employed.

** Incidentally, it is plain from the context that by "central heating furnaces" the patentee meant a furnace to which all the flues were connected, and not a furnace located centrally in the barn.

Leeds & Catlin v. Victor Talking Mach. Co., 213 U. S. 301, 318; Altoona Theatres v. Tri-Ergon Corp., 294 U. S. 477, 487 (24 USPQ 308, 313); Mercoid Corp. v. Mid-Continent Co., supra, 667 (60 USPQ at 25)."

Applying this rule to the claims of Patent No. 1,811,980 here in suit, if it be novel to combine oil burners with flues by providing "spaced openings in the bottom of the flue" and positioning "a fluid fuel burner" "under each such opening" the patentee is entitled to claims to that subcombination whether or not the number of burners employed is sufficient to provide the uniform heating of the entire flue area required to carry out the principal object of his invention.

As this case is before the court on a motion for summary judgment on the sole ground of non-infringement, the novelty of the combination recited in the claims is not here in issue.

That this arrangement has utility quite apart from the number of burners employed is self evident. The burner is placed directly on the ground so that the natural air currents carry the heated products of combustion into the overlying flue which protects the tobacco from direct radiation from the burners.

IV

Patent No. 2,051,348 is for the most part directed to a type of heating system for tobacco barns wherein the flues are discarded altogether. However, it shows in Figs. 15-18 a modification of the flue system forming the subject-matter of the earlier patent. Claim 3 here in suit is directed to this improvement. The arrangement of burners and flues in Patent No. 2,051,348 is precisely the same as in Patent No. 1,811,980, the improvement consisting in placing around each burner an enclosure or so-called "boxing" to prevent any escape

of the products of combustion into the barn (Pat. p. 3, col. 1, ll. 73 *et seq.* R. 97). The Court of Appeals questioned the applicability of this claim "taken literally" to the respondents' structure because in this claim the plurality of burners are described as arranged in series, etc., the Court apparently regarding "series" as implying more than two. Petitioners are not in accord with this view, and if this petition be allowed, will argue that the language of the claim, taken literally, does not exclude from its scope the respondents' structure.

Conclusion

By the granting of the motion for summary judgment petitioners have been denied the opportunity of establishing by competent evidence the nature and scope of their invention and its appropriation by respondents. Where the claims are so limited as to plainly exclude the respondents' structure, respondents may not be called to account, even though they have incorporated petitioners' invention in their drying houses, and the dismissal of the suit on motion would have been in order, but as the claims are not so limited, the motion should have been denied and the case remanded to the lower Court to try the fact issues presented by the pleadings.

WHEREFORE, petitioners earnestly pray that this petition for writ of certiorari be granted, the cause reviewed, and the decree of the Court of Appeals for the Fourth Circuit reversed.

Respectfully submitted,

CLARENCE M. FISHER,
W. BROWN MORTON,
Counsel for Petitioners.

Dated: New York, N. Y.,
September 8, 1949.